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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/935,377 09/22/97 ZAUDERER

M PENY4-628885

HM12/1227
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EXAMINER

EWOLDT, G

ART UNIT	PAPER NUMBER
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1644

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DATE MAILED:

12/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/935,377

Applicant(s)

Zauderer, M.

Examiner

Gerald Ewoldt

Group Art Unit

1644



☒ Responsive to communication(s) filed on Oct 13, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 68-120

is/are pending in the application.

Of the above, claim(s) _____

is/are withdrawn from consideration.

☐ Claim(s) _____

is/are allowed.

☒ Claim(s) 68-120

is/are rejected.

☐ Claim(s) _____

is/are objected to.

☐ Claims _____

are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 20

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Claims 68-120 are pending and being acted upon.
2. In view of Applicant's amendment, filed 10/13/00, including the cancellation of all previous claims, all previous rejections have been withdrawn.
3. The following are New Grounds of Rejection necessitated by Applicant's amendment, filed 10/13/00.
4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 68-120 are rejected under 35 U.S.C. § 112, first paragraph, as the specification does not contain a written description of the claimed invention, in that the disclosure does not reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the application was filed. This is a new matter rejection.

Specifically:

A) the "specific T-lymphocytes" of claim 68, have no clear support in the specification and claims as originally filed. The citations in the specification offered by the amendment in support of the new claim have been carefully reviewed and no disclosure of "specific T-lymphocytes" has been found. Additionally, the entire specification has been reviewed and no support for a claim of "specific T-lymphocytes" has been found.

Janeway and Travers (1994) teach that "cytotoxic T cells ... are distinguished by the cell surface molecule CD8." and "a different class of T cell [are] distinguished by surface expression of the molecule CD4." The reference further teaches "CD4 and CD8 ... characterize the two major subsets of T cells". Applicants previous base claims 1, 7, and 43 all recited the T cell subset (species) cytotoxic (CD8) T cells. New base claim 68 recites the unsupported and significantly expanded subgenus of "specific T cells".

The invention recited in claim 68 pertains to an invention which was not described in the specification and claims as originally filed because the specification and original claims as filed disclose a species, cytotoxic T cells, but do not disclose the subgenus recited in claim 68, specific T-lymphocytes. A genus may not support a subgenus even though there is a disclosed species within the genus and a subgenus is not necessarily described by a genus encompassing it and a species upon which it reads, *In re Smith* 173 USPQ 679, 683 (CCPA 1972). See MPEP 2163.05(b).

B) the term "facilitating expression" of Claim 70 has no clear support in the specification and claims as originally filed. The citation in the specification offered by the amendment in support of the new claim, page 50, line 27 - page 51, line 12, does not disclose the term.

C) the term "control region" of Claim 79 has no clear support in the specification and claims as originally filed. The citations in the specification offered by the amendment in support of the new claim, page 25, lines 3-5 and page 42, lines 19-23, do not disclose the term.

D) the term "counterpart" of Claim 92 has no clear support in the specification and claims as originally filed. The citations in the specification offered by the amendment in support of the new claim, page 1, lines 14-17 and page 14, lines 7-8, do not disclose the term.

Applicant is advised that should the claims be amended to recite the methods of the canceled Claims 43-67 the rejections previously made to said claims would be reinstated.

6. No claim is allowed.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee

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pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday and alternate Fridays from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

G.R. Ewoldt, Ph.D.
Patent Examiner
Technology Center 1600
December 20, 2000


Patrick J. Nolan, Ph.D.
Primary Examiner
Technology Center 1600